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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,197	05/23/2000	Kia Silverbrook	NPA001US	9186

24011 7590 05/07/2003

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,197

Applicant(s)

SILVERBROOK ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3+4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 3-2-01 and 3-12-01 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements were considered by the examiner.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The disclosure is objected to because of the following informalities: the related application information on page 1 is listed with the attorney docket numbers. Since the applications have since received US serial numbers, the attorney docket information should be replaced with the US serial numbers and all information should be updated as to status of such applications. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28, 33-35, and 41-47 are rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter. Claims 1, 4, 5, 10, 12, 16, 23, 26, 27, 33 and 42 claim a person which is not patentable subject matter.

Claims 2, 3, 6-9, 11, 13-15, 17-22, 24, 25, 28, 34, 35, 41, and 43-47 are indefinite because they depend from rejected base claims 1, 4, 5, and 33.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 8-20, 22, 24-28, 33-35, 41, 43-45 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the form" in line 1 of page 77. There is insufficient antecedent basis for this limitation in the claim. Should this form be *bill*?

Claims 8, 10, 12, and 15 all state "the parameter" when it should actually be "the *at least one* parameter" to be consistent with other occurrences of the same recitation.

Claim 33 recites the limitation "the person" in lines 2 and 4 on page 82. There is insufficient antecedent basis for this limitation in the claim. The first occurrence of the recitation should be "*a* person."

In claim 20, the term "substantially" renders the claim indefinite.

Claim 23 is confusing because it is unclear if the "particular person" is the same as the person previously identified in claims 1 & 4 or a different person. Clarification is required.

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Claims 9, 11, 13-19, 22, and 24-28 are indefinite because they depend from rejected base claim 4.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19, 21, 23-24, 26-40, 42-44 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by the Perazza patent (5,326,959).

The Perazza patent discloses a method of enabling bill payment of bills comprising the steps of providing a person with a bill containing information relating to a payment (col. 11, lines 1-13; receiving indicating data from a sensing device (col. 16, lines 29-54 and col. 11, lines 18-22); and identifying at least one parameter relating to the payment (col. 16, lines 24-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 20, 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent as applied to claims 1, 4, 5, 29, 32 and 33 above, and further in view of the PCT application WO 99/50787 (XEROX).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the data being substantially invisible (claims 20 and 45) and the sensing device having a marking nib (claim 41). The XEROX reference teaches the data being substantially invisible (page 8, lines 23-25) and the sensing device having a marking nib (505, page 14, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have substantially invisible data so as to interfere with other visible markings on the bill and to have a sensing device with a nib so that should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent as applied to claims 1, 4, and 5 above, and further in view of the Story patent (5,673,430).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the bill using a mixture of multicast and pointcast communication protocols (claim 22). The Story patent teaches the use of multicast and pointcast communication protocols (col. 3, lines 14-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to use multicast and pointcast communication protocols so as to reduce operating costs.

Claims 25 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent as applied to claims 1, 4, 5, 29, 32 and 33 above, and further in view of the Japanese Patent Abstract 10194562 A.

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the binding of a multipage bill (claims 25 and 47). The Japanese patent abstract reference teaches the binding of multiple pages of the bill (Solution portion of Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have a means of binding a bill having multiple pages so that the various pages will remain together and reduce the opportunity for them to become separated.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21, 25, and 29-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 23-24, 28-40 and 42-48 of copending Application No. 09/575,181. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because both sets of claims are directed to a method of enabling online bill payment, with the minor difference being a *bill* is claimed in the '181 application wherein a *form* is claimed in the '197 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The PCT application no. WO 97/14251 to AT & T discloses a system that uses multicast communications. The Hilt et al., Bednar et al., Comesanas, Anderson, Hughes et al., Kight et al., Hogan, Story and Pollin patents are directed to automatic bill payment systems. The Peters et al. patent is for a user account system. The Brindze et al. patent is for a storage drive that has a data head.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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March 18, 2003


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SUPERVISORY PATENT EXAMINER
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